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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 21

Serial Number: 07/352,530
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Appellant(s): Fabio et al.

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BOARD OF PATENT APPEALS
AND INTERFERENCES

OCT 7 1993

GROUP 2300

94-1648

Wayne P. Bailey
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to appellant's reply brief on appeal
filed 07-21-93.

1. Claim 27 stands rejected under 35 U.S.C. § 101 because
the claimed invention is directed to non-statutory subject
matter.

Appellant argues that a computer program on a medium is a
physical thing or product, thus, the claimed subject matter falls
within one of the four statutory classes of invention. However,
a compact disk with recorded music is a also physical thing, but
the information therein is not patentable. A computer program on
a disk is, likewise, information recorded on a medium, which
information fails to fall within any of the four statutory
classes of invention.

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2. The specification stands objected to under 35 USC 112 first paragraph, as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

Applicant argues the process which is disclosed in the specification, however, the specification has no support for a computer program, without more, carrying out the claimed functions.

3. Claim 27 stands rejected under 35 USC 112 first paragraph, for the reasons set forth regarding the objection to the specification.

4. Claim 27 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is claimed is a computer program, and appellant fails to point out how the computer program, without more, can carry out the claimed functions.

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5. Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over the well known data processing technique of storing a "computer program" on a storage media for later use by a computer.

What is claimed is a computer program residing on a medium. This is clearly well known in the art.

6. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Almis Jankus

AJ
September 29, 1993



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